

KL



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/309,264	05/11/1999	YUKIJI YODA	P7292-9003	7284

7590 05/22/2002

ARENT FOX KINTNER PLOTKIN & KAHN  
1050 CONNECTICUT AVENUE, N.W.  
SUITE 400  
WASHINGTON, DC 20036-5339

EXAMINER

DEJESUS, LYDIA M

ART UNIT	PAPER NUMBER
----------	--------------

2859

DATE MAILED: 05/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/309,264

Applicant(s)

YODA ET AL.

Examiner

Lydia M. De Jesús

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 through 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshida.

Yoshida discloses a machining system, shown for example in Figure 14, that during its normal operation will perform a work-form measuring method comprising the steps of: placing a work on a waiting position of an auto pallet changer [APC4] corresponding to the pallet changer position at the inlet of a coordinate measuring machine [MUNT], directly after said work is machined by a machining tool [MT1]; bringing a probe of said coordinate-measuring machine [MUNT] close to said work in said waiting position of said auto pallet changer and then measuring the forms and dimensions of said work, said coordinate-measuring machine being in the vicinity of said machine tool.

With respect to claims 2-3: The limitations stated in claims 2 and 3, although proper, are insufficient to patentably distinguish the claimed method from the Prior Art because they are directed to structural features of the invention and not to method steps to which claim 1 is directed.

Art Unit: 2859

With respect to claim 4: Inherently, said coordinate-measuring machine is capable of taking refuge to such a position as that said coordinate measuring machine does not prevent said work from moving.

3. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Yoshida.

Yoshida discloses (see Figure 14) a coordinate-measuring machine [MUNT] disposed in the vicinity of a machining tool [MT1], said coordinate-measuring machine inherently including a probe.

With respect to the limitations “for getting a probe thereof close to a work in a waiting position of an auto pallet changer of said machining tool, having been machined by said machining tool, placed on said waiting position, to thereby measure the forms and dimensions of said work”: Said limitations, although proper and understood to be intended to provide a clear description of the claimed apparatus, are insufficient to patentably distinguish the Prior Art from the claimed apparatus because they fail to set forth structural limitations of said coordinate measuring machine and further since they are directed to the manner in which the coordinate-measuring machine is to be used and it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshida.

Yoshida discloses a work form measuring apparatus (See Figure 14) comprising an auto pallet changer [APC4] and a coordinate measuring machine [MUNT] which inherently has a probe.

With respect to the limitations “for moving a work between a waiting position and a machining position at an inlet of a machining tool” and “for bringing a probe thereof close to said work in said waiting position of said auto pallet changer, directly after said work is machined by said machining tool and placed on said waiting position, to thereby measure the forms and dimensions of said work”: Said limitations are directed to the manner of operation of the pallet changer and of the coordinate-measuring machine and they fail to further set forth structural elements of the claimed apparatus and hence are functional statements that, although proper, are insufficient to patentably distinguish the claimed apparatus from the prior art since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

With respect to claims 6-8: The coordinate measuring machine inherently comprises refuge means for causing said coordinate –measuring machine to take refuge to such a position as that said coordinate-measuring machine does not prevent said work from moving. The particular direction of motion in which the coordinate measuring machine takes refuge is considered to be a choice of design or engineering skill.

With respect to the method steps stated in claims 9 and 10: These method steps are insufficient to patentably distinguish the claimed apparatus from the prior art since this claim is directed to an apparatus and since the courts have held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Official Notice is taken with respect to the limitations in claim 11 since it is very well known to provide a coordinate measuring machine with a rotating means i.e., pivoting worktable, for rotating the work which is placed on a measuring position.

Furthermore, Applicant should note that the limitations regarding the interaction of the pallet changer or the coordinate measuring machine with the machining tool, although proper and understood to be intended to provide a clear description of the claimed apparatus, do not serve to distinguish the claimed apparatus from the prior art since they refer to the manner in which the apparatus is intended to be employed and lack structural limitations of the pallet changer or the coordinate-measuring machine per se.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Foreign Patent Document JP2002018667 A discloses a related apparatus.


Art Unit: 2859

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lydia M. De Jesús whose telephone number is (703) 306-5982.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 305-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

LDJ  
May 20, 2002

  
Diego F.F. Gutierrez  
Supervisory Patent Examiner  
Technology Center 2800